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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MYERS, PAUL R

ART UNIT PAPER NUMBER

2111

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/696,153	Applicant(s) LUNSFORD ET AL.	
	Examiner Paul R. Myers	Art Unit 2111	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,30,31,34-37,39 and 43-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10,30,31,34-37,39 and 43-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/24/06 have been fully considered but they are not persuasive.

In regards to applicants argument that PN 6,523,124 claims a “detecting a signal on a signal line to determine whether a communication device is actively connected”: This is correct and as currently claimed the claim language teaches “detecting that an external communication device is actively connected to communicate” There is no patentable distinction between these two claim elements while there may be different means for detecting connectivity the use of a signal line for said detection is notoriously well known. Further the fact that the claims of Patent No. 6,523,124 include the additional limitation of a signal line which detects whether a communication device is actively coupled. See *In re Emert* 44 U.S.P.Q.2D (BNA) 1149 states “Absent some indication of unexpected properties, the combination [A and B] renders B[1] obvious” *Emert* at 11. In the present case the current claims claim detecting is a device is actively coupled without indicating what type of device or how it is detected. Thus the A in the *Emert* example is the signal line and the device being a communications device.

In regards to applicants argument that dependant claim 4 introduces a signal line that is used for the purpose of determining the type of communication device. This does not alleviate the fact that claim 1 of the current application is still double patenting over claim 1 of PN 6,523,124 in view of *Sakai et al* PN 5,613,135. Further using a signal line to determine the type of communications device is notoriously well known as evidenced by *Kobayashi* PN 5,463,742. It would have been obvious to a person of ordinary skill in the art to determine the type of

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communications device because this would have allowed for using the correct control/communications program.

In regards to applicants argument that that “claim 1 is not ‘detecting that an external device is actively connected and providing power’ as stated in the office action. Rather, the limitation of claim 1 recites: ‘detecting that an external computing device is actively connected to communicate and provide power to the portable computing device’”: The rejection was Sakai et al PN 5,613,135 in view of Townsley et al PN 5,557,738 and Kobayashi PN 5,463,742. Sakai teaches detecting that an external device (AC adapter) is actively connected and providing power (Column 7 lines 62 to Column 8 line 19) to the portable computing device. Kobayashi teaches Kobayashi teaches detecting that an external computing device is actively connected to communicate and that provides power to a portable computing device (Via the PPM detection switch). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In regards to applicants argument that the AC adapter of Sakai is not a computing device nor does the AC adapter communicate to the portable device: The examiner agrees. Again Kobayashi teaches detecting that an external computing device is actively connected to communicate and that provides power to a portable computing device (Via the PPM detection switch). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In regards to applicants argument that “claim 1 recites ‘responsive to detecting the external computing device, suspending execution of at least a portion of a program’ The combined references do not teach this limitation”: This is clearly incorrect. Sakai teaches responsive to detecting the device that provides power, suspending execution of at least a portion of a program (The power save portion). Kobayashi teaches the device that provides power is an external computing device that is connected to provide power and communicate. Thus the combination teaches responsive to detecting the external computing device, suspending execution of at least a portion of a program.

In regards to applicants argument that the portable processing module of the system of Kobayashi is a paired device that is not independently functional and the that the laptop of Sakai is fully functional, and independent of another device: This does not alleviate the fact that it would have been obvious to a person of ordinary skill in the art at the time of the invention to have a fully functional laptop as the personal processing module of Kobayashi because this would have allowed of independent operation or because this would have provided for expandable capabilities to the notebook of Sakai and allowed the personal processing module to have direct user control.

In regards to applicants argument that Kobayashi teaches away from the claimed invention: This is clearly incorrect. Kobayashi does not state that you would not want to expand the capabilities of a laptop or expand the capabilities of the PPM.

In regards to applicants argument that “because the laptop of Sakai is fully functional on its own, and does not need a docking station to operate, one skilled in the art would find no purpose in the combination of Sakai and Kobayashi”: This is clearly incorrect see above.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-10, 30-31, 34-37, 39, 43-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,523,124 in view of Sakai et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims merely remove limitations of the allowed claims. The claims of PN 6,523,124 is silent as to the newly external device is providing power. Sakai et al teaches the claimed external device providing power (AC adapter). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the claimed providing power because this would have prevented power depletion with power saving disabled. See also *In re Emert* No. 96-1559 U.S. CAFC 44 U.S.P.Q.2D (BNA) 1149.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-8, 34-45, 43-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai et al PN 5,613,135 in view of Townsley et al PN 5,557,738 and Kobayashi PN 5,463,742.

In regards to claims 1, 43-44, 51: Sakai et al teaches a method of operating a portable computing device (portable computer), the method comprising: detecting that an external device (AC adapter) is actively connected and providing power (Column 7 lines 62 to Column 8 line 19) to the portable computing device; and responsive to said detecting, suspending execution (power save mode is invalidated) of at least a portion of a program (power save mode) that would otherwise reduce power consumption of the portable computing device. Sakai does not expressly teach that the power save mode would reduce power consumption of the portable device after a given duration of inactivity. Sakai does teach that the power save mode includes a suspend mode. Although the examiner does not know of any suspend mode that does not monitor a given duration of inactivity to start power reduction, Sakai does not expressly state this is how the power save mode functions. Therefore for the sake of argument Townsley et al is cited which does expressly teach a power save mode that reduces power consumption of a computing device after a given duration of inactivity (Figure 2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include Townsley's sleep state in

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the power save mode of Sakai et al because this would have allowed for full power operation when the user is active. Sakai et al does not teach the external device that provides power is a computing device that also communicates to the portable computing device. Kobayashi teaches a portable computing device that is plugged into an external computing device that provides power to the portable computing device and communicates with the portable computing device. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use Sakai et al's laptop as a portable personal processing module in the system of Kobayashi because this would have provided for expandable capabilities to the notebook of Sakai and allowed the personal processing module to have direct user control. Kobayashi also teaches a user causing communications to the PPM via the external docking station.

In regards to claim 2: Townsley et al teaches the duration of inactivity is a time out feature.

In regards to claim 4: Kobayashi teaches a signal from the external computing device, and determining a type of external computing device using the signal (A type code is provided by each docking station and configures the PPM accordingly).

In regards to claim 5: Sakai et al does not expressly teach the selective control being in response to coupling of the external device. Sakai et al does however teach selective control of the power save mode (hot key etc). It would have been obvious to include selective control in the coupling function because this would have allowed for greater user power control.

In regards to claim 6: Sakai et al teaches invalidating of the power down mode.

In regards to claim 7: Sakai et al teaches a measurement of the voltage level (V) (Figure 21 into 74).

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In regards to claim 8: Sakai et al teaches the adapter is a plug in adapter. Sakai et al does not teach the form of the plug. Kobayashi teaches a parallel connector. Official notice is taken that serial connectors are well known. It would have been obvious to use a serial connector because this would have decreased the number of pins and decreased cost of manufacturing.

In regards to claim 47: Sakai et al teaches displaying information including such items as power mode, percent power of the battery etc. Sakai et al does not expressly teach that the displayed information can include such items as a world clock, digital images from a digital camera, and network data. It would have been obvious to allow displaying of any images accessed because this would have prevented limiting the functionality of the system.

In regards to claims 34-35 and 45-46: Sakai et al teaches displaying at maximum illumination when not in power save mode.

In regards to claims 48-50: Sakai teaches decreasing brightness in power save mode. Sakai also teaches turning of non-essential hardware in power save mode. Sakai does not expressly teach the portable computer having a backlight. Official notice is taken that back lights are common in displays. It would have been obvious to include a backlight because this would have decreased glare.

6. Claims 3, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai et al PN 5,613,135 in view of Townsley et al PN 5,557,738 and Kobayashi PN 5,463,742 as applied to claim 2 above, and further in view of "Two-Way Power Line Communication" by Ed Nisley herein after Nisley.

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In regards to claims 3, 43: Sakai teaches the activation/deactivation of sleep mode as described above. Sakai et al does not teach transmitting one or more communications from the portable computing device using the external device when the external device is actively connected to the computing device. Nisley teaches two way communications over the power line. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide communications from the portable computing device of over the AC lines because this would have prevented the need to also connect a network cable as well as an AC input.

Allowable Subject Matter

7. Claims 9, 10, 30, 31, 36, 37 and 39 are allowable over the prior art.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PN 5,710,911 to Walsh et al clearly teaches (Figure 1) a fully functional laptop with its own I/O that docks into a docking station and when docked uses the I/O of the docking station. Further Walsh also teaches detecting that an external computing device (the docking station) is actively connected to communicate and provide power to the portable computing device (Laptop).

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9. This application is an RCE. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

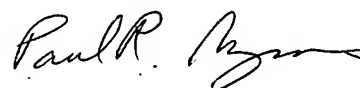
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 571 272 3639. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (571) 272-3632. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PRM
December 1, 2006



PAUL R. MYERS
PRIMARY EXAMINER